

REMARKS/ARGUMENTS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1, 27, 35, 40 and 47 have been amended to more particularly point out and distinctly claim the present invention. Claims 8-10, 15-16, 21, 24-26, 37-39, 44-46 and 50-52 have been canceled. New claim 53 has been added. Claim 53 provides that the heterocyclic group recited in claim 27 has a N bound within the ring and has 4 to 6 carbon atoms. Support for new claim 53 may be found in the present specification at pages 26, 39 and 40.

In the outstanding Official Action, claims 1, 24-27, 32-35, 37-40, 44-47 and 50-52 were rejected under 35 USC §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. It is believed that the present invention obviates this rejection.

The outstanding Official Action rejected the claims for containing the terms "wherein R1 is Me or I-Pr, R2 is not H" and "substituents". However, the claims have been amended in a manner so that this term is no longer recited.

The outstanding Official Action further alleged that the term "heterocyclic containing N" was indefinite. However, Applicants traverse this contention. While the term may be broad, one of ordinary skill in the art would find the term definite. As the Examiner is aware, the test of definiteness is whether one skilled in the art would understand the scope of the claim when read in light of the specification. *Bausch & Lomb Inc. v. Alcon Labs Incorp.*, 64 F.2d 233, 52 USPQ 2d 1385 (DCWDNY 1999). Thus, while the term may be broad, Applicants believe that one of ordinary skill in the art would understand the scope of the term. Nevertheless, the new claim 53 has been added to recite that the heterocyclic containing N is a ring having 4 to 6 carbon atoms with a N bound within the ring. Thus, it is believed that the recitations are definite to one of ordinary skill in the art.

The outstanding Official Action also rejected the claims for containing the terms "novel" and "general". The Official Action alleged that these terms were superfluous. The claims have also been amended so that these terms are no longer recited.

Thus, it is believed that the claims are definite to one of ordinary skill in the art.

Claims 24-26, 32-34, 37-39, 44-46 and 50-52 were rejected for allegedly being substantial duplicates of other. In the interest of advancing prosecution, claims 24-26, 32-34, 37-39, 44-46 and 50-52 have been canceled.

In the outstanding Official Action, claims 1, 8-10, 15-16, 24-26, 35-52 were rejected under 35 USC §102(b) as allegedly being anticipated by, or in the alternative, under 35 USC §103(a) as obvious over HOELTJE et al. 5,418,224, KIRST et al. 0 296 717 or GIDDA et al. 4,920,102. This rejection is respectfully traversed.

The Examiner's attention is respectfully directed to claim 1. Claim 1 is directed to a pseudoerythromycin derivative represented by formula 1. In formula 1, R1 and R2 are the same or different and each represents an H, alkyl, alkynyl, acyl, or sulfonyl group. However, compounds wherein each R1 and R2 are independently H, methyl, ethyl, or propyl are excluded.

Applicants believe that the cited publications, alone or in combination, fail to disclose or suggest the claimed invention. Indeed, none of the cited publications suggest a pseudoerythromycin derivative represented by formula 1 wherein when R1 and R2 are independently H, methyl, ethyl, or propyl are excluded. Thus, it is believed that claim 1 is definite.

As to claims 3-7, 11-14, and 17-23 the Examiner declared that these claims would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. As it is believed that claim 1 has been amended to place it in condition for allowance, it is believed that claims 3-7, 11-14, 17-20 and 22-23 are also allowable.

The Examiner's attention is also directed to amended claims 27-31. In the outstanding Official Action, the Examiner declared that claims 27-31 were only objected to for being dependent upon a rejected base claim. It is believed that claim 27 is definite to one of ordinary skill in the art. Thus, as no publications have been cited against independent claim 27 and its corresponding dependent claims (28-31), it is believed that the rejection of claims 27-31 must be withdrawn.

Claims 35 and 36 are directed to a pseudoerythromycin derivative represented by formula 3. In formula 3, R1 is NOH. Applicants believe that the publications of HOELTJE et al., KIRST et al. or GIDDA et al. all fail to disclose a compound having formula 3 wherein R3 is NOH. Thus, it is believed that claims 35 and 36 are allowable.

Claims 40-43 are directed to a pseudoerythromycin derivative represented by formula 4. Applicants believe that the

publications of HOELTJE et al., KIRST et al. and GIDDA et al., alone or in combination with each other, do not anticipate or render obvious the claimed invention. The compounds of claims 40-43 are based on formula 4 wherein R1 and R2 are same or different and each represents H or methyl, and R3 and R4 represent an H, hydroxyl, or an amino. Upon reviewing the cited publications, it is believed that none of the publications teach a compound represented by formula 4 wherein R3 and R4 may represent an H, hydroxyl, or an amino. Thus, it is believed that the rejection of claims 40-43 must be withdrawn.

Claims 47-49 are directed to a pseudoerythromycin derivative represented by formula 5. Formula 5 lacks the cladinose group commonly found in erythromycin derivatives. As the cited publications all fail to disclose or suggest a compound lacking the cladinose group, Applicants state that the cited publications in the outstanding Official Action fail to anticipate or render obvious the claimed invention.

In view of the present amendment and the foregoing remarks, therefore, it is believed that this application is now condition for allowance, with claims 1, 3-7, 11-14, 17-20, 22-23, 27-31, 35-36, 40-43, 47-49 and 53, as presented. Allowance and passage to issue on that basis are accordingly respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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